



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,495	03/18/2004	Donald R. Titterington	D/A0306IID	7713

21567 7590 09/28/2006

WELLS ST. JOHN P.S.
601 W. FIRST AVENUE, SUITE 1300
SPOKANE, WA 99201

EXAMINER

SERGEANT, RABON A

ART UNIT PAPER NUMBER

1711

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/804,495	Applicant(s) TITTERINGTON ET AL.	
	Examiner Rabon Sergeant	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 21-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/18/04, 1/24/06</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1711

1. It is requested that applicants amend the specification to reflect the current status of the parent application, 09/654,735.
2. The distinction between claims 22 and 23 and claims 28 and 29 is unclear. Since the fused ring alcohol of claims 21 and 27 include at least three fused rings, it is unclear how the limitations of the respective claims differs.
3. Claims 21-32 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the production and use of phase change materials comprising monomeric, oligomeric, or non-polymeric reaction products of isocyanates and alcohols, does not reasonably provide enablement for the production of polymeric materials derived from isocyanates and alcohols. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Applicants have failed to provide enablement for the use and production of polymeric urethane resins, to be used within phase change ink compositions; however, applicants' claims are not so limited. The position is taken that one of ordinary skill could not practice the instant invention using polymeric materials without having to resort to undue experimentation. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1711

5. Claims 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Hays ('477).

Patentees disclose the production of oligomeric reaction products of isocyanates and rosin-based capping agents, such as hydroabietyl alcohol, suitable for use within ink compositions. See abstract; column 3, lines 21+; column 4, lines 7+; and column 7, lines 23-26. In view of the disclosed product and its use and the reactants of the prior art, it is not seen that the preamble of claim 27 distinguishes the claims from the prior art.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

Art Unit: 1711

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 21-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the following claims of the following copending applications:

<u>Application</u>	<u>Claim</u>
10/898,724	19 and 20
10/902,602	96 and 97
10/918,619	13 and 14
11/291,057	57 and 58
11/496,231	27
11/496,612	21 and 22

Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of copending claims is drawn to phase change ink compositions or their use, wherein the compositions are derived from fused ring alcohols, such as hydroabietyl alcohol, and either cyclohexyl isocyanate or isophorone diisocyanate. The position is taken that one of ordinary skill in the art in possession of the phase change ink composition would have also been in possession of the method of making it. Furthermore, the phase change ink

Art Unit: 1711

composition, by its very name and nature, renders the use of the composition, to the extent claimed, obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 21-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the following claims of the following U.S. Patents:

<u>U.S. Patent</u>	<u>Claim</u>
6860931	18 and 19
6835238	18 and 19
6811596	10 and 11
6755902	18 and 19
6726755	18 and 19
6878198	26
6858070	23 and 26
6790267	12 and 13
6764541	12 and 13
6761758	19
6673139	18 and 19
6663703	18 and 19
6180692	All
6057399	All
6048925	All

Art Unit: 1711

6015847	All
5994453	All
5919839	All
5780528	All
6872243	66 and 67
6821327	18 and 19
6811595	19
5830942	All
5827918	All
5783658	All
5782966	All
5750604	All
6620228	2-5 and 10-16
6946025	6 and 7
6989052	All
7033424	59 and 60
7084189	16 and 17
7094812	27 and 28

Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of copending claims is drawn to phase change ink compositions or their use, wherein the compositions are derived from fused ring alcohols, such as hydroabietyl alcohol, and either cyclohexyl isocyanate or isophorone diisocyanate. The position is taken that

Art Unit: 1711

one of ordinary skill in the art in possession of the phase change ink composition would have also been in possession of the method of making it. Furthermore, the phase change ink composition, by its very name and nature, renders the use of the composition, to the extent claimed, obvious.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
September 26, 2006


RABON SERGENT
PRIMARY EXAMINER